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Paper No. 10

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**COPY MAILED**

**AUG 13 2004**

In re Application of  
Brown  
Application No. 09/821,314  
Filed: March 29, 2001  
Attorney Docket No. 10508/001  
For: LAUNDRY CART

**OFFICE OF PETITIONS**  
**ON PETITION**

This is a decision on the petition under 37 CFR 1.137(a), filed June 21, 2004 (certificate of mailing date June 16, 2004), to revive the above-identified application.

The petition is **DISMISSED**.

Any further petition to revive the above-identified application must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Petition under 37 CFR 1.137." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

It is noted that Inventor Jerome Brown has signed the instant petition. Applicant has appointed attorneys to conduct all business before the Patent and Trademark Office. Double correspondence with an applicant and applicant's attorneys will not be undertaken. Accordingly, applicant is required to conduct all future correspondence with this Office through the attorneys of record.

The above-identified application became abandoned for failure to fully reply to the to the Notice to File Missing Parts of Nonprovisional Application, mailed May 9, 2001, which required petitioner to submit an executed oath or declaration, a \$65.00 surcharge for the late filing of an executed oath/declaration and substitute drawings in compliance with 37 CFR 1.84 within an extendable two (2) month period. On July 16, 2001 (certificate of mailing date July 11, 2001), Attorney Joseph N. Breaux submitted an executed declaration and power of attorney, a verified small entity statement, a check for the \$65.00 surcharge, and a check in the amount of \$55.00 for a one month extension of time to reply to the May 9, 2001 Notice. On August 29, 2001, the Office mailed a Notice of Incomplete Reply (Nonprovisional), which reminded petitioner that the substitute drawing requirement was still outstanding and that the original period for reply set in

the May 9, 2001 Notice had not been changed. No timely reply was received in the Office. Accordingly, the above-identified application became abandoned on August 10, 2001. A Notice of Abandonment was mailed on October 24, 2003.

The Office acknowledges receipt a sheet of drawing containing Figure 1, filed with the instant petition.

The revocation and power of attorney filed with the instant petition has been entered and made of record.

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by (1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof; (2) the petition fee as set forth in § 1.17(l); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section. This petition does not satisfy requirement (3).

Regarding (3), the showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.137(a). Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, telefacsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

The Commissioner may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Commissioner to have been "unavoidable". 35 USC § 133. Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term 'unavoidable' "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

In the instant case, petitioner has failed to provide adequate evidence that the delay was

unavoidable. Petitioner asserts that the delay in responding fully to the May 9, 2001 Notice was unavoidable due to his attorney's inattention.

Because petitioner was represented by a registered practitioner, the Office must rely on the actions or inactions of the duly authorized and voluntarily chosen representatives of the applicant, and the applicant is bound by the consequences of those actions or inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962). If the attorney made any errors, petitioner is bound by such errors.<sup>1</sup>

The attorney must act reasonably and prudently.

If [the] attorney somehow breach[es] his duty of care to plaintiff, then plaintiff may have certain other remedies available to him against his attorney. He cannot, however, ask the court to overlook [the attorney's] action or inaction with regard to the patent application. He hired the [attorney] to represent him. [The attorney's] actions must be imputed to him.<sup>2</sup>

The Seventh Circuit has stated,

The other assumption is that, if the complainants failed in their application through the negligence of their attorney, the delay would be unavoidable, which is wholly unwarranted in the law. It is of the very nature of negligence that it should not be unavoidable, otherwise it would not be actionable. The negligence of the attorney would be the negligence of the [client]. The purpose of the statute was to put an end to such pleas, and there would be no limit to a renewal of these applications if every application, however remote, could be considered under the plea of negligence of attorneys, by whom their business is generally conducted.<sup>3</sup>

The United States Court of Appeals for the Federal Circuit has stated,

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<sup>1</sup> See California Med. Products v. Technol Med. Products, 921 F. Supp. 1219, 1259 (D. Del. 1995) (citing Smith v. Diamond, 209 U.S.P.Q. 1091, 1093 (D.D.C. 1981) (citing Link v. Walbash Railroad Co., 370 U.S. 626, 8 L. Ed. 2d 734, 82 S. Ct. 1386 (1962))).

<sup>2</sup> Haines v. Quigg, 673 F. Supp. 314, 317, 5 U.S.P.Q. 2d (BNA) 1130 (citing Link v. Walbash Railroad Co., 370 U.S. 626, 8 L. Ed. 2d 734, 82 S. Ct. 1386 (1962)) ("Petitioner voluntarily chose his attorney as his representative in the action and he cannot now avoid the consequences of the acts or omissions of this freely selected agent ... Each party is deemed bound by the acts of his lawyer-agent and is considered to have 'notice of all facts, notice of which can be charged upon the attorney.'" (emphasis added); Inryco, Inc. v. Metropolitan Engineering Co., Inc., 708 F.2d 1225, 1233 (7th Cir. 1983) ("Courts hesitate to punish a client for its lawyers gross negligence, especially when the lawyer affirmatively misled the client" but "if the client freely chooses counsel, it should be bound to counsel's actions."); see also Wei v. State of Hawaii, 763 F. 2d 370, 372 (9th Cir. 1985); LeBlanc v. I.N.S., 715 F.2d 685, 694 (1st Cir. 1983)). See also Smith v. Diamond, 209 U.S.P.Q. (BNA) 1091 (D. D.C. 1981).

<sup>3</sup> Lav v. Indianapolis Brush & Broom Mfg. Co., 120 F. 831, 836 (1903).

If we were to hold that an attorney's negligence constitutes good cause for failing to meet a PTO requirement, the PTO's rules could become meaningless. Parties could regularly allege attorney negligence in order to avoid an unmet requirement.<sup>4</sup>

In the instant case, the attorney responsible for the prosecution of this case did not act as a reasonable and prudent person in relation to his most important business. Mr. Brown believed that Mr. Breaux would handle any requirements set by the Office. Mr. Breaux did not submit a substitute drawing sheet for his client. Petitioner is informed that the client is responsible for any delay caused by lack of communication between the attorney and client and the delay is not considered unavoidable within the meaning of 37 CFR 1.137(a). In re Kim, 12 USPQ2d 1595 (Comm'r Pat. 1988).

While Mr. Brown was prompt in attempting revival once he had notice of this application's abandonment, Mr. Brown must bear the consequences of his chosen representative's mistakes/inattention. Mr. Breaux's health problems have no discernable impact on the analysis at hand because they occurred in August of 2003 and the events at issue occurred in 2001.

The petition under 37 CFR 1.137(a) is **DISMISSED**.

### ALTERNATIVE VENUE

Petitioner should consider filing a petition stating that the delay was unintentional. Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to provide for the revival of an "unintentionally" abandoned application without a showing that the delay in prosecution or in late payment of an issue fee was "unavoidable." This amendment to 35 U.S.C. § 41(a)(7) has been implemented in 37 CFR 1.137(b). An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the \$ 665.00 petition fee.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay can not make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

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<sup>4</sup> Huston v. Ladner, 973 F.2d 1564, 1567, 23 U.S.P.Q.2D (BNA) 1910 (Fed. Cir. 1992).

Further correspondence with respect to this matter should be addressed as follows:

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Telephone inquiries concerning this decision should be directed to the undersigned at (703) 308-6712.



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